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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/069,061	09/04/2002	Rainer Blum	P 290585	8997

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EXAMINER

PADGETT, MARIANNE L

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 02/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/069,061

Applicant(s)

BLUM ET AL.

Examiner

Marianne L. Padgett

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 November 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 and 11-14 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-9 and 11-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1762

1). A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 11/29/04 has been entered.

2). The inclusion of specific types of electrical components as substrates in the independent claims, removes Hwang et al (5,705,232) as a reference, as it is directed semiconductor integrated circuits, not transformer, or components with windings or conducting wires.

The terminal Disclaimer of 12/32/04 removes the obviousness double patenting of section 15 of the 7/29/04 rejection over PN 6,146,717 in view of Linderoth.

In claim 4 “coats” in line 2 has been effectively informally changed to --coat--, however this change makes sense in the context of the claim language, and applicant alleges that they did amend it, and the strike through just went unnoticed, however there is no strike through visible in the scanned file, probably due to degradation due to scanning and the printer who also use the scanned file would never have deleted the “s”, hence in the future the examiner suggest using deletion option of double brackets, [[]], that it is possible to see. Given the explanation on the record, the wording of claim 4 will be considered acceptable.

Applicant's amendment to the specification to define “Dobeckan MF 8001 UV-2” is noted, as is the statement that they have provided a provisional data sheet as support, however no copy of this data sheet is found in the scanned file, and the examiners are not allowed to order the original paper copies of submissions or cases. The examiner will request that the IFW

Art Unit: 1762

personnel look for this sheet to add to the file, but as of this time the addition to p. 10 is unsupported. (As of 1/31/05 no such data sheet has been added to the scanned file.)

3). The amendment filed on 11/28/04 is objected to under 35 U.S.C. 132 because it introduces new matter into the disclosure. 35 U.S.C. 132 states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Until the alleged provided support is available to the examiner for review, the amendment to page 10 must be considered New Matter.

Applicant is required to cancel the new matter (or provide the cited support) in the reply to this Office Action.

4). In the previous amendment (3/2/04), claim 11 depended from claim 10, hence in the current amendment (11/29/04) the recitation of "in claim 1" in line 1 is informal. As claim 11 says its "Currently Amended" but shows no actual amendment (unless it contains more effectively invisible amendments like that 3/2/04 claim 4?), it appears that this was unintentionally omitted.

5). The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6). Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley et al (EPO 065 147) as discussed in section 4-5 paper #7 (11/28/03) and section 6 of the paper mailed 7/29/04.

Art Unit: 1762

Applicant's argue on p.7 of their 11/29/04 response that Buckley et al only "gel" their coatings citing the definition therein of gelling only being partial polymerization, however the examiner notes that whether the polymerization is partial or complete, that "curing" within the scope of the generic "curing" of the claims has occurred, hence unless the claims specify a degree of curing that differs from Buckley et al, this argument can not be considered convincing. Furthermore, for the apparatus claims 12-14, it's irrelevant as this use of the apparatus is irrelevant to its structure, since the degree of curing is a method limitation.

With respect to amendments that incorporate limitations from claims 10-11 of impregnation techniques and specific components, the examiner notes Buckley is specifically directed to claimed electrically conductive windings or coils, and the formation method described on p.3 of their specification may apply single layer(s) to a winding, where the viscosity is such that it minimizes the chance for pockets or voids to develop, thus may be considered to read on impregnation between the winding's wires, that would be consistent with the claimed "trickling". It is again noted that Buckley et al's teachings do not specifically state use of NIR, but do teach use of any IR or visible radiation, thus is inclusive of near IR, and it remains considered obvious to employ any wavelength in the disclosed range, dependant on the particular polymer's curing properties.

7). Claims 7-9 remain rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley et al as applied to claims 1-14 above, and further in view of Lienert (DE 19648133 A) as previously presented in section 6 of paper #7.

8). With respect to Linderoth et al (4,234,624), the examiner will agree that as now claimed Linderoth will not read on the process, since the liquefied extruded polymeric material

Art Unit: 1762

surrounds a single wire to produce a cable, and unless that cable is porous, no impregnation can occur, since a single wire as opposed to the plural, etc., required in claim 1, has no intricacies between wires to impregnate.

9). Claim 12 remains rejected under 35 U.S.C. 102(b) as being anticipated by Linderoth et al.

The apparatus only requires a NIR heat source and means of applying a composition or lacquer to a surface, which Linderoth clearly does, as previously presented (section 8, paper of 7/29/04), especially as the nature or effect of the applied coating is a method limitation with no necessary apparatus structure.

10). Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Linderoth as applied in section 10 of paper mailed 7/29/04.

11). Claims 1-14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Buckley et al, optionally in view of Lienert (for claims 7-9) as applied to claims 1-14 above, and further in view of Linderoth et al as discussed in section 9 of 7/29/04.

Linderoth et al remains relevant to the process for showing the specific usefulness of NIR in curing the types of polymers used for electrical insulation, hence continues to provide motivation to Buckley et al's teaching for specifically picking the NIR range out of the overall taught IR range considered applicable, since extrusion on a single cable verse Buckley et al's coating on windings would not effect the wavelength applicable for curing the polymer applied, to whatever degree of cure is desired.

12). Applicant's arguments filed on 11/29/04 and discussed above have been fully considered but they are not persuasive.

Art Unit: 1762

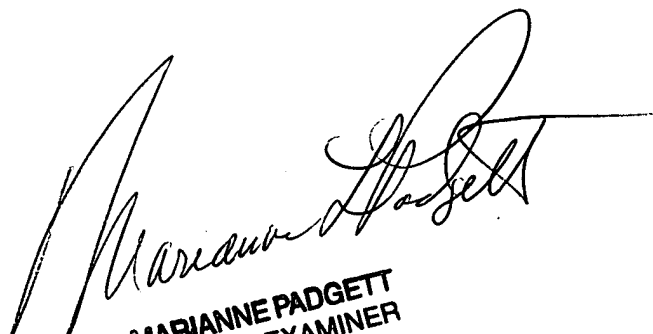
13). Other art of interest include Thunhorst et al (6,759,080 B2) or Baumbach et al (6,790,485 B2), who coat polymeric materials, and teach possible NIR curing, and thus apparatus implied by taught procedures.

14). Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. L. Padgett whose telephone number is (571) 272-1425. The examiner can normally be reached on Monday-Friday from about 8:30 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Beck Shrive can be reached on (571) 272-1415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Padgett/LR
January 24, 2005
January 31, 2005



MARIANNE PADGETT
PRIMARY EXAMINER